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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,683	01/14/2000	Alex Holtz	1752.0010001	7339

7590 06/24/2002

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EXAMINER

HUYNH, BA

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 06/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/482,683

Applicant(s)  
Holtz et al

Examiner  
First Last

Art Unit  
1234

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5, 6
- 4) ☐ Interview Summary (PTO-413) Paper No(s).
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

BA HUYNH  
PRIMARY EXAMINER

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## **DETAILED ACTION**

### ***Declaration by Alex Holtz***

1. The declaration filed by Alex Holtz fails to comply with 37 CFR 1.68 which requires the declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-17 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention as evidenced by the Alex Holtz's declaration in conjunction with the exhibits A, B, C

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submitted on 3/09/01. Disclosed in the declaration are numerous marketing activities by the applicants since 1996 which bring the claimed invention within the scope of a bar to patenting under 35 USC 102(b), including:

- 1996: Graphically disclosed the invention at the NAB 96 trade show.
- 4/1997: Demonstrated the first prototype, distributed brochures, market exploited, proposed price, list of potential beta sites was kept, among which is Rainbow Media Group. All at the NAB 97.

Sometime after the NAB 97: Discussed sale with price to public, including Rainbow Media Group.

- 6/1997: In Infocom trade show, repeated the same activities as in NAB 97.
- 10/1997: Disclosed the product (with significant portion of source codes), distributed brochures describing features and functions of the product at Telecon 97 trade show. Offered sale with price to public, including Rainbow Media Group. Capable and ready for taking purchase order.
- 12/19/1997: Sign a sale contract with Rainbow Media Group.

4. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent RE37,342 (Washino et al) .

- As for claims 1, 2, 3, 8, 9: Washino et al teaches a computer implemented method and corresponding apparatus for transmitting a video stream from a source in a video production

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environment to a destination, the video production environment having a processing unit in communication with one or more video production devices, comprising the steps/means for:

creating a first script containing time code segment stamps to identify specific segments within the video stream (col. 2, lines 14-16),

receiving a request (implicitly included) to transmit one or more video segments in a designated format,

retrieving the time codes associated with the video segments from the first script and inserting the time codes into a second script to control the transmission (col. 7, lines 26-30)

receiving instructions to transmit data related to the video segments, thereby inserting codes associated with the related data into the second script,

defining a set of video production commands corresponding to the second script, and executing each video production command wherein the executing step includes sending a command to a video production device to synchronously transmit the video segment and the related data to a destination (col. 6, lines 6-65). The video segment can be viewed in a selected order (col. 7, lines 49-54).

- As for claim 4: Advertisements can be transmitted with the video segment (col. 8, lines 13-16).

- As for claim 5: It is inherently included that the video production command and the video segment must be downloaded to a viewing station to be viewed.

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- As for claim 6: The video show comprises a plurality of video segments. Washino fails to clearly teach providing a list of the video segments for user selection. However implementation of the list would have been obvious to one of skill in the art. Motivation of the implementation is for having an hierarchical organized of the video segments for manipulation.

- As for claim 7: Cut-in segment can be selected to allow inserting of late breaking event which is not in the list (col. 7, lines 35-37).

- As for claim 10: Each of the video segment has a time stamp associated with it (col. 7, lines 26-29).

### **Inquires**

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 746-7238 may be used for formal After Final communications, (703) 746-7239 for Official communications, or (703) 746-7240 for Non-Official or draft communications. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huynh-Ba whose telephone number is (703) 305-9794. The examiner can normally be reached on Monday-Friday from 8.00AM to 4.30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

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set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Huynh-Ba  
Primary Examiner  
Art Unit 2173  
6/14/02

  
BA HUYNH  
PRIMARY EXAMINER